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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,522	01/24/2002	Federico Granzotto	BA-22808	4324
178	7590	05/19/2004	EXAMINER	
BUCKNAM AND ARCHER 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			WELLS, LAUREN Q	
		ART UNIT	PAPER NUMBER	
		1617		

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/057,522	GRANZOTTO, FEDERICO	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 6-27 are pending. The Amendment filed 1/26/04 , cancelled claims 1-5 and added claims 6-27.

Applicant states in the response of 1/26/04, “the applicant herewith submits a Substitute Declaration in compliance with the Examiner’s request therefore”. However, no Substitute Declaration has been filed. Thus, for the reasons stated in the previous Office Action, the oath/declaration is still defective.

Applicant’s amendment to the specification and abstract are sufficient to overcome the objection to the specification in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 7 is rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language (e.g., “. . . selected from the group consisting of. . . and . . .”). Are “cosmetic products” part of the Markush group? Or is the Markush group cosmetic products selected from those things which follow this phrase?

(ii) Claims 25-27 are vague and indefinite, as they are confusing. The phrase “are used” in these claims makes it appear that a sol solution, a gel solution, and an aerosol solution are an intended use. Is Applicant merely attempting to limit the form of the composition or is this an

intended use limitation? The Examiner suggests the following to overcome this rejection: delete the phrase “wherein said first component silica and said second component water are use”.

NOTE: “Ethoxydiglycol” is incorrectly spelled in claims 10 and 18. Also, “EDTA” should be capitalized in claim 23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 14-15, 17, 21-22, 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb (5,658,573) in view of Ha et al. (5,997,887).

The instant invention is directed toward a composition comprising 0.1-3% silica and 97-99.9% water.

Holcomb exemplifies a composition comprising 58.39% water, 0.83% of an aqueous suspension of colloidal silica, 8.44% mineral oil (excipient), 4% glycerine (excipient). For 0.25% panthenol, see Col. 7, lines 3-8. See Col. 7, lines 29-54. The reference lacks preferred percent weight of water, propylene glycol, xanthan gum, algar, algin, dimethicone copolyol, and salicylic acid.

Ha et al. teach skin care compositions and methods of improving skin appearance. For emulsions that comprise 1-99.98% water, see Col. 5, lines 18-27. For solutions, aerosols, emulsions, and gels as cosmetic composition forms, see Col. 5, lines 56-67. For propylene

glycol as a hydrophilic diluent, see Col. 6, lines 1-12. For xanthan gum, algar, and algin as polymeric thickeners, wherein thickeners comprise 0.01-10% of the composition, see Col. 11, lines 13-27; Col. 6, lines 24-34. For dimethicone copolyols as emulsifiers comprising 0.05-5% of the compositions, see Col. 19, lines 23-35; Col. 22 ,lines 61-67. For salicylic acid as a preferred anti-oxidant comprising 0.1-10% of the composition, see Col. 27, line 59-Col. 28, line 38. For propylene glycol and panthenol as skin conditioning components comprising 1-99.99% of the composition, see Col. 28, line 39-Col. 29, line 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Holcomb to exemplify water as comprising 97% of the composition a) because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233); b) because of the expectation of achieving a product that flows and that can be applied over a large surface area; c) because Ha et al. teach that it is within the skill of the artisan in the cosmetic emulsion art to modify the amount of water to achieve different cosmetic forms.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add xanthan gum, algar, or algin, as taught by Ha et al., to the composition of Holcomb a) because Ha et al. teach these compounds as conventional cosmetic ingredients; and b) because of the expectation of achieving a thickened composition that can be more precisely applied to a specific skin area.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add dimethicone copolyol, as taught by Ha et al., to the composition of Holcomb a)

because Ha et al. teach this compound as a conventional cosmetic ingredients; and b) because of the expectation of achieving a more stable composition that solubilizes both hydrophilic and hydrophobic components.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add salicylic acid, as taught by Ha et al., to the composition of Holcomb a) because Ha et al. teach this compound as a conventional cosmetic ingredients; and b) because of the expectation of achieving a product with a longer shelf life and that protects the skin from UV radiation which causes increased scaling or texture changes in the stratum corneum, and against other environmental agents that cause skin damage, see Col. 27, lines 52-58 of Ha et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add propylene glycol, as taught by Ha et al., to the composition of Holcomb a) because Ha et al. teach this compound as a conventional cosmetic ingredients; and b) because of the expectation of achieving a product that conditions the skin.

It is respectfully pointed out that the above composition is a sol, as a sol is defined as a colloid solution consisting of a suitable dispersion medium.

It is respectfully pointed out that, the recitation "Anti-wrinkle cosmetic product", has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Art Unit: 1617

Claims 9-10, 13, 16, 18, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb in view of Ha et al. as applied to claims 6-8, 14-15, 17, 21-22, 24-27 above, and further in view of Schiltz (6,495,126).

Holcomb et al. and Ha et al. are applied as discussed above. The reference lacks disodium EDTA, aloe barbadensis, ethoxydiglycol, glycerin in a preferred amount, and sodium hyaluronate.

Schiltz teaches cosmetic compositions for treating aged and environmentally damaged skin. For 0.01-5% disodium ETA as a chelating agent that activates one or more of the resident stratum corneum protease chymotryptic enzymes, which causes a loss of adherence between corneocytes, thus allowing them to be shed at faster rate, see Col. 5, line 60-Col. 6, line 67. For aloe barbadensis, ethoxydiglycol, glycerin and sodium hyaluronate as moisturizers, see Col. 8, line 25-Col. 9, line 56.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add disodium EDTA, as taught by Schiltz, to the composition of the combined references because of the expectation of beautifying the skin by causing the corneocyte cells to be shed at a faster rate.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add aloe barbadensis, ethoxydiglycol, glycerin and sodium hyaluronate, as taught by Schiltz, to the composition of the combined references a) because of the expectation of achieving a product that moisturizes the skin; and b) because the combined references teach propylene glycol as a moisturizing agent, and the combined references teach propylene glycol,

aloe barbadensis, ethoxydiglycol, glycerin and sodium hyaluronate, as interchangeable moisturizing agents.

While Schiltz does not teach the amount of moisturizing agents to add to the composition, Ha et al. teach the amount of moisturizing agent (i.e., skin conditioning agents) to add the composition.

Claims 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb in view of Ha et al. as applied to claims 6-8, 14-15, 17, 21-22, 24-27 above, and further in view of Dubois et al. (6,126,930).

Holcomb and Ha et al. are applied as discussed above. The references lack sodium polyacrylate.

Dubois et al. teach person care compositions. For sodium polyacrylate, agar, algin, and xanthan gum as thickeners comprising 0.01-20% of the composition, see Col. 4, line 20-Col. 5, line 11.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute sodium polyacrylate, as taught by Dubois et al., for the thickeners of the composition references a) because the combined references teach agar, algin, and xanthan gum as thickeners and Dubois et al. teach sodium polyacrylate, agar, algin, and xanthan gum as interchangeable thickeners; and b) because of the expectation of achieving equivalent thickening effects.

Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb in view of Ha et al. as applied to claims 6-8, 14-15, 17, 21-22, 24-27 above, and further in view of Cupferman et al. (2002/0098211).

Art Unit: 1617

Holcomb and Ha et al. are applied as discussed above. The references lack capryly glycol, wherein caprylyl glycol is 1,2-octanediol.

Cupferman et al. teach antimicrobial agents for use in cosmetics and dermatology. For 1,2-octanediol as an anti-microbial agent, see [0015].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 1,2-octanediol (caprylyl glycol), as taught by Cupferman et al., to the combined composition because of the expectation of achieving a product that is protected against microorganisms that grow in the composition, see [0003] of Cupferman et al.

Response to Arguments

Applicant argues, “it appears evident that this reference discloses a particular and complicated method of generating a cosmetic product whereas in the present invention, no method of generating a cosmetic product is disclosed”. This argument is not persuasive. Holcomb teach and exemplify cosmetic composition as laid out in the above rejections.

Applicant argues, “each product of this reference is used for different skin treatment and does not produce a tensor effect to stretch skin and make it smoother. The reason for this is that it uses an insufficient quantity of silica which cannot produce a tensor effect and which serves to facilitate adsorption of moisturizing agents into the skin”. This argument is not persuasive, as it is in no way commensurate in scope with the instant claims. The instant claims are product claims, method methods of producing tensor effects. Additionally, Holcomb teach silica in an amount recited in the instant claims.

Applicant argues, “the Holcomb patent and its purpose of a different and innovative function is totally unrelated to any hydrating formulation like that of Holcomb because the

present claimed composition functions as a skin tensor that stretches wrinkles and makes skin smooth". This argument is not persuasive. For the reasons stated in the above paragraph, this argument is not even commensurate in scope with the instant claims. It is additionally pointed out that, the recitation "anti-wrinkle" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw


SREENI PADMANABHAN
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